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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,342	01/26/2001	Mark G. Fleischhacker	LRM-33657	6291
56080 7590 10/03/2007 WHYTE HIRSCHBOECK DUDEK S.C. 33 East Main Street, Suite 300 Madison, WI 53703-4655			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 10/03/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/770,342

Applicant(s)

FLEISCHHACKER, MARK G.

Examiner

Jonathan ML Foreman

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. In view of applicant's arguments and reconsidering the merits of the application the finality of the rejection of the last Office action is withdrawn.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4 and 6 – 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,251,640 to Osborne.

In regard to claims 1, 2, 4 and 6 – 9, Osborne discloses a guide wire consisting essentially of a core wire (20) having a distal, medial and proximal segments, the core wire having a tapered segment (Figure 2) between the medial segment and the distal segment, substantially comprising a non-metallic, non-braided, non woven, polymeric material (Col. 3, lines 18 – 21; Col. 4, lines 8 – 11). The distal segment has a diameter which is less than that of the core wire medial and proximal segments (Figure 2). The core wire has a polymeric coating thereon which covers substantially the entire length of the core wire (Col. 5, lines 7 – 10). The core wire includes a taper (Figure 2). The core wire comprises a polymeric material and is covered completely with a second polymeric material (Col. 4, lines 8 – 11; Col. 5, lines 7 – 10).

Art Unit: 3736

4. Claims 1, 2, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,454,788 to Walker et al.

In regard to claims 1, 2, 7 and 9, Walker et al. discloses a guide wire consisting essentially of a core wire (22) having a distal, medial and proximal segments, the core wire having a tapered segment between the medial segment and the distal segment, substantially comprising a non-metallic, non-braided, non woven, polymeric material (Col. 15, lines 12 - 18). The distal segment has a diameter which is less than that of the core wire medial and proximal segments.

5. Claims 1, 2, 4 and 6 - 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,944,701 to Dubrul.

In regard to claims 1, 2, 4 and 6 - 9, Dubrul discloses a guide wire consisting essentially of a core wire (Figure 1) having a distal, medial and proximal segments, the core wire having a tapered segment (Col. 3, lines 16 - 20) between the medial segment and the distal segment, substantially comprising a non-metallic, non-braided, non woven, polymeric material (Col. 3, lines 45 - 46). The distal segment has a diameter which is less than that of the core wire medial and proximal segments (Col. 3, lines 16 - 17). The core wire has a polymeric coating thereon which covers substantially the entire length of the core wire (Col. 3, lines 28 - 31). The core wire includes a taper (Col. 3, lines 16 - 17). The core wire comprises a polymeric material and is covered completely with a second polymeric material (Col. 3, lines 45 - 46; Col. 3, lines 28 - 31).

6. Claims 1, 2, 4 and 6 - 9 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,354,989 to Nudeshima.

In regard to claims 1, 2, 4 and 6 - 9, Nudeshima discloses a guide wire consisting essentially of a core wire (2a) having a distal, medial and proximal segments, the core wire having a tapered segment (Col. 4, lines 10 - 12) between the medial segment and the distal segment, substantially

Art Unit: 3736

comprising a non-metallic, non-braided, non woven, polymeric material (Col. 3, lines 60 – 61). The distal segment has a diameter which is less than that of the core wire medial and proximal segments (Col. 4, lines 10 – 12). The core wire has a polymeric coating (7) thereon which covers substantially the entire length of the core wire. The core wire includes a taper (Col. 4, lines 10 – 12). The core wire comprises a polymeric material and is covered completely with a second polymeric material ((Col. 3, lines 60 – 61; Col. 4, lines 32 – 41).

### ***Response to Arguments***

7. Applicant's arguments filed 9/18/07 have been fully considered but they are not persuasive. Applicant asserts that the Examiner has completely and assiduously disregarded the command in the MPEP that subsequent examiners are to accord “full faith and credit” to the examiner actions of prior examiners. Applicant points to MPEP 704.01 (reproduced below).

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner **unless there is a clear error in the previous action or knowledge of other prior art.**

In the present case, the Examiner new of other guide wires formed of a polymeric material that were not previously cited. Accordingly, the Examiner did what was proper and did not completely and assiduously disregard the command in the MPEP.

Applicant asserts that the Examiner's interpretation of claim 1 is incorrect. However, claim 1 first uses the transitional phrase “consisting essentially of” to state that the guide wire includes a core wire. Claim 1 then uses the open transitional phrase “substantially comprising” to relate to the construction of the core wire. Accordingly, the Examiner has taken care to search and apply art related to a guide wire having a core wire and those elements that do not materially affect the basic and novel characteristic(s)” of the claimed invention. Wherein the core wire may include additional,

Art Unit: 3736

unrecited elements. It is noted that for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., PPG, 156 F.3d at 1355, 48USPQ2d at 1355

In regard to Osborne, Osborne discloses a taper. It is irrelevant that the taper is formed by staggering different lengths of composite fibers embedded in a matrix and not by centerless grinding. The majority of the core (“substantially comprising”) as disclosed by Osborne is made up of a non-metallic, non-braided, non woven, polymeric material.

In regard to Dubrul, it is clear that Dubrul discloses a guide wire. In fact, the disclosure of Dubrul beginning at column 3, line 45 reproduced by Applicant in the latest response begins, “the **guide wires** of the present invention could also be formed from known shape memory polymers...”. Furthermore, Dubrul makes several references to guide wires throughout the disclosure. Applicant additionally states that the disclosure of Dubrul is not enabled. Applicant states that known shape memory polymers are known only to Mr. Dubrul. However, the Examiner disagrees. One having ordinary skill in the art would readily recognize that shape memory polymers are a class of polymers that have shape memory characteristics. A simple search of issued patents and/or of the Internet produces hundreds of pieces of information about known shape memory polymers and their chemical names. As such, Dubrul need not include any trade designation, manufacturer, internal synthesis or any other information as these polymers are well known and information regarding them is readily accessible.

In regard to Nudeshima, it is noted that the term “guide wire” found in the claims offer no structural difference than the wire disclosed by Nudeshima. The wire member 2a as disclosed by Nudeshima is disclosed as having a size, flexibility and operational characteristics sufficient to allow

Art Unit: 3736

a catheter to pass over its body. Thus, it is fully capable of being a guide wire. Applicant asserts that the “consisting essentially” phrase would eliminate any and all structure relating to delivery of radiation sources. However, the Examiner has found no clear indication in the specification or claims that a radiation source would materially affect the basic and novel characteristic(s) of the claimed invention. Accordingly, “consisting essentially of” has been properly construed as equivalent to “comprising.” See, e.g., PPG, 156 F.3d at 1355, 48USPQ2d at 1355.

The Examiner contends for the above mentioned reasons that the present claims remain anticipated by the cited prior art.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

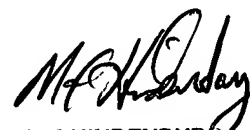
Art Unit: 3736

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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